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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,661	01/27/2004	James Henry Orszulak	2053 CON 3	3026

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EXAMINER

GIBSON, ROY DEAN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,661

Applicant(s)

ORSZULAK ET AL.

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Formal Matters

The Terminal Disclaimer requested in the last Office action was received and approved.

After additional searching the examiner has found prior art for many of the claims, therefore, the allowability of claims presented previously is withdrawn except as indicated below.

Claim Rejections - 35 U.S.C. § 112

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the electrosurgical energy" in line 3. There is a lack of proper antecedent basis for this limitation in the claim. The examiner suggests "surgical generator" in claim 1 be replaced with "electrosurgical generator" to correct this.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by McMahan (5,681,307).

As to claim 1, McMahan discloses a qualifying connection for a recognition apparatus for identifying a type of surgical instrument attached to a surgical generator, the qualifying connection comprising:

a plug (20) having a mechanical interface (34) which matingly engages a corresponding mechanical interface (14) disposed on the surgical generator;

a first optical coupling (surface of plug 30 with concentric rings 32) disposed on the plug and a second optical coupling (Figure 4) disposed on the generator, the couplings optically communicating upon mating engagement of the plug and generator, and when arranged for optical communication, communicating identifying information to the generator relating to the type of surgical instrument (Figures 1-4 and col. 1, lines 25-30 and 42-63, col. 2, lines 6-54 and col. 4, line 34-col. 7, line 22).

As to claims 2, 3 and 8, McMahan further discloses an identifying circuit which includes a memory (214) for controlling activation of electrosurgical energy according to a predetermined criteria for the type of instrument identified and a switch (Figures 4 & 5) disposed in the generator and in electrical communication with at least one optical coupling which differentiates the type of surgical instrument attached to the generator and which provides a signal to the generator upon verification of the type of surgical instrument attached thereto (col. 6, line 66-col. 7, line 22 and col. 9, lines 35-56). Note

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the switch is responsible for ceasing operation until corrective action is taken to avoid operation in an incorrect or unsafe manner).

As to claim 4, McMahan further discloses the optical coupling on the plug includes a light modifier (32) which modifies (reflects or fails to reflect) the radiation of light for thereafter receipt of the optical coupling on the generator, the modified radiation of light being indicative of the type of surgical instrument connected to the generator (Figure 4 and col. 6, line 66-col. 8, line 60).

As to claim 6, McMahan further discloses the light modifier of the optical coupling on the plug includes a pre-selective light responsive material (col. 6, line 66-col. 7, line 22).

As to claim 7, McMahan further discloses the optical coupling of the generator includes at least one light transmitter and the light modifier on the plug alters the optical energy transmitted from the at least one transmitter (col. 8, lines 4-32).

As to claim 9, McMahan further discloses a display (224) capable of providing visual feedback as to the type of surgical instrument attached to the generator (col. 9, line 50-col. 10, line 37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McMahan. McMahan fails to disclose the wavelength of the laser diodes used, however, the examiner maintains that it is general knowledge that LEDs of infrared wavelengths and associated photodiodes are frequently used in commercial instruments for coding of data or information.

Allowable Subject Matter

Claims 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

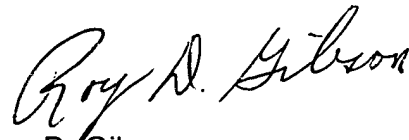
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Roy D. Gibson". The signature is written in a cursive, flowing style.

Roy D. Gibson
Primary Examiner
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August 23, 2005